

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Dean A. Schaefer et al. Confirmation No.: 9215
Serial No.: 10/774,739 Examiner: Quynh-nhu Hoang Vu
Filing Date: February 9, 2004 Group Art Unit: 3763
Docket No.: 1001.1386102 Customer No.: 28075
For: INTRAVASCULAR CATHETER WITH MULTIPLE AXIAL FIBERS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 22nd day of October 2008.

By Kathleen L. Bockley
Kathleen L. Bockley

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached four sheets of arguments.

This Request is signed by an attorney or agent of record.

Respectfully submitted,

Dean A. Schaefer et al.

By their Attorney,

Date: 10/22/08

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Attachment: Four Sheets of Pre-Appeal Conference Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

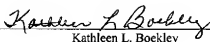
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PRE-APPEAL CONFERENCE BRIEF**CERTIFICATE FOR ELECTRONIC TRANSMISSION:**

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By


Kathleen L. Bockley

Dear Sir:

Appellants have carefully reviewed the Final Office Action dated May 28, 2008 and the Advisory Action dated August 18, 2008. Currently, claims 16-20 and 22-32 are pending in the application and claims 16-20 and 22-32 stand finally rejected. Appellants hereby request a pre-appeal conference and file this Pre-Appeal Conference Brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

Claim Rejections under 35 U.S.C. § 102

On page 3 of the Final Office Action, claims 16-17, 20, 22, 24, and 29-39 were rejected under 35 U.S.C. § 102(b) as being anticipated by Webster, Jr. (U.S. Patent No. 5,057,092). After careful review, Appellants respectfully traverse this rejection.

Turning to claim 16, which recites:

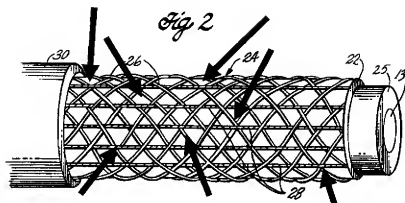
16. An intravascular catheter comprising an elongate shaft having a reinforcement layer comprising a tubular braid having a first helical member interwoven with a second helical member and a plurality of axial members disposed between the first helical member and the second helical member for the entire length of the axial member.

Nowhere does Webster, Jr. teach or suggest at least “a plurality of axial members disposed between the first helical member and the second helical member for the entire length of the axial member”, as recited in claim 1.

In the Final Office Action, the Examiner asserted that the limitation “for the entire length of the axial member” is a functional limitation and does not impose any structural limitation upon the claimed apparatus. Appellants respectfully disagree. Clearly, the disposition of the axial member between the first and the second helical member for the entire length of the axial member is a structural feature of the catheter braid. Such a limitation requires the axial member to be internal to one of the first and second helical members and external to the other of the first and second helical members along the entire length of the axial member. In such a configuration, the inner and outer surfaces of the catheter may not have protrusions that would negatively impact the performance of the catheter. Therefore, Appellants respectfully submit that “for the entire length of the axial member” is a structural limitation and the failure of the Examiner to consider this limitation is clear error.

Webster, Jr. teaches an intravascular catheter including an elongated catheter body having a flexible plastic inner wall 22, a braided reinforcing mesh 24 surrounding the inner wall 22, and a flexible plastic outer wall 30 surrounding the reinforcing mesh 24. The braided reinforcing mesh 24 includes a plurality of interwoven helical members 26. Webster, Jr. teaches that, typically, half of the interwoven helical members 26 extend in one direction and the other half of interwoven helical members 26 extend in the counter direction. In addition, the braided reinforcing mesh 24 includes longitudinal warp members 28. However, the longitudinal warp members 28 are not disposed between first and second helical members 26 for the entire length of the longitudinal warp member. Instead, the longitudinal warp member 28 is disposed external to or internal to the first and second helical members 26 at points along the length of the longitudinal warp member 28. In such a configuration, the longitudinal warp members 28 are not disposed between first and second helical members 26 for the entire length of the longitudinal warp member.

To further illustrate this, Figure 2 of Webster, Jr. has been reproduced below with a number of arrows indicating example portions of the braided reinforcing mesh 24 where the longitudinal warp member 28 is not disposed between the helical members 26.



As can be clearly seen, the longitudinal warp members 28 of Webster, Jr. are not disposed between the helical members 24 for the entire length of the longitudinal warp member 28.

As the Examiner is well aware, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (MPEP § 2131). Webster, Jr. fails to teach each and every element of claim 16, in particular, “a plurality of axial members disposed between the first helical member and the second helical member for the entire length of the axial member”. Therefore, for at least these reasons, claim 16 is believed to be not anticipated by Webster, Jr. Furthermore, there is no reason to modify the teachings of Webster, Jr. to arrive at the claimed invention. Thus, claim 16 is patentable over Webster, Jr., and Appellants respectfully request withdrawal of the rejection. For similar reasons and others, claims 17, 20, 22, and 24, which depend from claim 16 and include additional limitations, are believed to be patentable over Webster, Jr., and Appellants respectfully request withdrawal of the rejection.

Turning to claim 29, which recites:

29. A method of making a portion of a shaft of an intravascular catheter, the method comprising the steps of:

braiding a first helical member and a second helical member about a carrier such that a plurality of axial members are disposed between the first and second helical members for the entire length of the axial member.

As discussed previously, nowhere does Webster, Jr. teach or suggest “a plurality of axial members are disposed between the first and second helical members for the entire length of the axial member.” Therefore, for at least these reasons, claim 29 is believed to be patentable over

Webster, Jr., and Appellants respectfully request withdrawal of the rejection. For similar reasons and others, claims 30-39, which depend from claim 29 and include additional limitations, are believed to be patentable over Webster Jr., and Appellants respectfully request withdrawal of the rejection.

Claim Rejections under 35 U.S.C. § 103

On page 4 of the Final Office Action, claims 18-20, 31-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Webster, Jr. (U.S. Patent No. 5,057,092). After careful review, Appellants must respectfully traverse this rejection. As discussed previously, claims 16 and 29 are believed to be patentable over Webster, Jr. Therefore, claims 18-20 and 31-32, which depend from claim 16 and claim 29, respectively, are believed to be patentable over Webster, Jr.

On page 5 of the Final Office Action, claims 23 and 25-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Webster, Jr. (U.S. Patent No. 5,057,092) in view of Mortier et al. (U.S. Patent No. 5,730,733). After careful review, Appellants must respectfully traverse this rejection. As discussed previously, claim 16 is believed to be patentable over Webster, Jr. and nothing in Mortier et al. remedies the noted shortcomings of Webster, Jr. Therefore, for at least these reasons, claims 23 and 25-28, which depend from claim 16 and include additional limitations, are believed to be patentable over Webster, Jr. and Mortier et al.

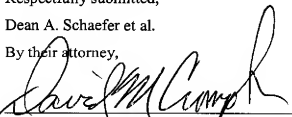
Conclusion

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Dean A. Schaefer et al.

By their attorney,



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